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10/088,018	03/13/2002	Christophe Nicolas	3829-049 NATL	4937

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DLA PIPER LLP (US)
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EXAMINER

HUSSAIN, FARRUKH

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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In re Application of: Christophe NICOLAS et al.
Application No. 10/088018
Filed: March 13, 2002
For: METHOD AND SYSTEM FOR
TRANSMITTING A CHAIN OF
MESSAGES FOR DATABASE

**DECISION ON PETITION
UNDER 37 C.F.R. § 1.181**

This is a decision on the petition filed June 30, 2010 under 37 CFR § 1.181 to invoke Supervisory Authority and require the Examiner to withdraw the Finality of office action mailed June 22, 2010.

The petition is **GRANTED**.

RELEVANT PROSECUTION HISTORY

Nov 17, 2009	The Examiner issued a non final rejection rejecting claims 1, 3-9, and 12-15 under 35 U.S.C. 101 as being non-statutory and rejection all pending claims 1, 3-10, 12-16 and 18 under 35 U.S.C. 103(a) as being unpatentable over Deiss (US 5,802,063), in view of Khan (US 6,654,422 B1) and Wong (US 5,978,787).
Mar 17, 2010	An amendment was filed by the applicant amending independent claims 1, 10, 16 and 18; dependent claims were amended by virtue of their independency.
Jun 22, 2010	The Examiner issued an office action finally rejected all pending claims (1, 3-10, 12-16 and 18) under 35 U.S.C. 103(a) as being unpatentable over Deiss (US 5,802,063), in view of Khan (US 6,654,422 B1) and Wong (US 5,978,787) and <i>further in view of Yorimitsu (US 5,835,940)</i> .
Jun 30, 2010	The instant petition was filed requesting withdrawing the Finality of the action mailed Jun 22, 2010.

REGULATIONS AND PRACTICE

MPEP 706.07(a) states in part that:

Under present practice, second or any subsequent action on the merits **shall be made final, except** where the examiner introduces a new ground of rejection not necessitated by amendment of the application by the applicant, whether or not the prior art is already of record.

MPEP 706.07(d) states in part that:

If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.

Once the finality of the Office action has been withdrawn, the next Office action may be made final if the conditions set forth in MPEP § 706.07(a) are met.

MPEP 707.07(f) states in part that:

Where the applicant traverses any rejection, *the examiner should*, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

MPEP § 1201 states, in part:

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board ...

37 C.F.R. § 1.181(f) states, in part:

The mere filing of *a petition will not stay any period for reply* that may be running against the application, nor act as a stay of other proceedings...

DECISION

A review of the file history indicates in the amendment filed Mar 17, 2010, applicant argued against the combination of Wong with Deiss and Klan; and further amended claims 1 and 10 to include the limitations:

after the message has been locally stored, reading the memory of the subscriber database device and determining that the condition associated with the locally stored message has been fulfilled;

and processing the locally stored message after determining that the condition associated with the locally stored message has been fulfilled

In the Final office action of June 22, 2010, the examiner relied upon the newly cited reference of *Yorimitsu* for the teaching of the amended limitation above; claim 16 and 18 were rejected for the same rationale as detailed in the rejection of claim 1. However, it is noted that claims 16 and 28 were not amended to include the above cited limitations; claims 16 and 18, as presented prior to the Non-Final rejection of Nov 17, 2009, included the following limitation:

locally storing ... each management message member that is subject to a condition that has not been fulfilled ... processing ... when the condition has been fulfilled

Thus, the new ground of rejection for claims 16 and 18 with respect to the *Yorimitsu* reference was not necessitated by applicant's amendment. Thus the finality of the action mailed June 22, 2010 is improper.

For the above stated reasons, the petition is **GRANTED**.

The Finality of the Office action mailed June 22, 2010 is hereby removed and the action has been changed to Non-Final. The period for response continues to run from the mailing date of the action on June 22, 2010.

Any inquiry concerning this decision should be directed to Kim Huynh, whose telephone number is (571) 272-4147.

/Nancy Le/

Nancy Le, Director
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